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1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 *Ex parte* GIACOMO STEFANO ROBA, MASSIMO NUTINI and
11 FRANCO VERONELLI

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14 Appeal No. 2009-014244
15 Application No. 09/986,622
16 Technology Center 1700

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19 Oral Hearing Held: April 14, 2010

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22 Before MICHAEL COLAIANNI, LINDA M. GAUDETTE, and
23 JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

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1 THE USHER: Calendar Number 30, Appeal Number 2009-014244.

2 Mr. Alexander.

3 JUDGE COLAIANNI: Good afternoon, Mr. Alexander.

4 MR. ALEXANDER: Good afternoon.

5 JUDGE COLAIANNI: Welcome to the Board.

6 MR. ALEXANDER: Thank you.

7 JUDGE COLAIANNI: We have a court reporter that will be transcribing
8 today's proceedings. If you have a business card you could give it to her either
9 now or at the end.

10 MR. ALEXANDER: I do.

11 JUDGE COLAIANNI: You'll have 20 minutes and you can begin when you're
12 ready. Also let me just state that you can focus on the art rejection in this case.
13 You don't need to go into the 112 rejection unless you want to.

14 MR. ALEXANDER: Okay. Thank you. Good afternoon. My name is
15 Cortney Alexander with Finnegan, Henderson. I represent Prysmian Cable
16 Systems.

17 There are two independent claims at issue in this appeal, 51 and 61. Claim 51
18 recites in relevant part the distribution ring being adapted to direct a second
19 portion of the conditioning gas to an upper portion of the annular distribution
20 chamber.

21 The Examiner rejected this claim and in particular said that this element was
22 satisfied by U.S. Patent Number 4,988,374 to Harding. And the basis for the
23 Examiner's rejection is that while Harding does not disclose a channel or path
24 that would distribute gas in an upward direction through the distribution ring,

1 he asserts that Harding would inherently meet these limitations under certain
2 operating conditions.

3 And he provides examples for how this might happen. For example, the
4 Examiner contends that one could place a vacuum above the furnace to draw
5 gas up to the upper portion of the distribution chamber or one could place a
6 pressurizing device at the bottom of the furnace to achieve the same result.

7 But in order for the prior art reference to inherently disclose a feature, it must
8 be the necessary result of that reference's operation. And here the Examiner
9 has pointed to nothing in Harding that would suggest placing a vacuum at the
10 top of the furnace to draw the conditioning gas up or to place a pressurizing
11 device at the bottom.

12 Therefore, it is not the necessary result of Harding and Harding does not
13 inherently disclose directing conditioning gas to an upper portion of the
14 chamber. So we ask that the rejection be reversed on that ground.

15 But in addition, even assuming that Harding did inherently suggest placing a
16 vacuum at the top of the furnace or a pressurizing device at the bottom of the
17 furnace, that wouldn't meet the claim limitation. The limitation requires that
18 the distribution ring be adapted to direct a second portion of conditioning gas
19 to an upper portion of the distribution chamber. Under the Examiner's
20 proposed modifications to Harding, it would be the vacuum or the pressurizing
21 device that would cause the gas to rise.

22 Harding, as you can see in Harding's Figure 1, discloses only
23 downwardly-angled channels through the distributor body. And, in fact, it
24 includes arrows that show the gas entering in the chamber in a downward
25 direction. So whatever proposed modifications the Examiner suggests,

1 Harding's distribution ring remains adapted to introduce the gas in a downward
2 direction and is not adapted to direct the gas in an upward direction.

3 JUDGE GAUDETTE: Doesn't the Examiner rely on Element 8A for
4 directing?

5 MR. ALEXANDER: Yes, ma'am, he did. If you look at Harding's disclosure
6 at, I believe it is Column 3, Line 35, it states that the gas supply is reintroduced
7 before the top iris 8A is opened to allow the fresh preform to be introduced.
8 Actually earlier in that same column at Line 22 it refers to the irises 8A and
9 16A being closed to seal the entrance.

10 So based on this disclosure we don't understand 8A to be a port through which
11 gas would be introduced. Even if it were, we don't believe that it is in any way
12 adapted to cause gas -- to direct gas to the upper portion of this distribution
13 chamber.

14 JUDGE GAUDETTE: Where did that argument appear in your Briefs?

15 MR. ALEXANDER: I don't know that that argument was in the Briefs. I do
16 believe that Appellants were clear that Harding includes no disclosure. It
17 shows that the distribution ring would be adapted to direct gas to an upper
18 portion of the distribution chamber. That disclosure of Harding, I believe, just
19 provides further support for that position.

20 The Examiner also relied on Harding with respect to Claim 61 -- I'm sorry --
21 yeah, Independent Claim 61 which recites in the relevant part the distributor
22 body including at least one upwardly-angled path to direct a second portion of
23 the positioning gas to an upper portion of the distribution chamber.

24 And I know Your Honor said that I need not address the 112 rejection, but I do

1 believe that the Examiner's position on this rejection is based at least in part on
2 his rejection of Claim 61 under 112, Paragraph 2, interpreting the
3 upwardly-angled path to potentially encompass a flow of gas or a path that is
4 undelineated by any sort of structure.

5 And we believe that that is not a reasonable interpretation of the phrase
6 "upwardly-angled path" recited in Claim 61. And I'm happy to address that
7 further if you would like.

8 But moving on to Harding's disclosure. As I was saying with respect to Claim
9 51, Harding discloses only a downwardly-angled channel that directs gas in a
10 downward direction into the chamber. And, in fact, Claim 61 also recites a
11 downwardly-angled channel to direct gas in a downward direction just like
12 Harding shows there and the Examiner relied on this portion of Harding in
13 order to show that Harding discloses that downwardly-angled channel
14 limitation.

15 And I think this provides further evidence that Harding's downwardly-angled
16 channel cannot also -- cannot be both the downwardly-angled channel and the
17 upwardly-angled path.

18 At one point in the Examiner's Answer, I believe the Examiner suggested that
19 the main bore of Harding could be the upwardly-angled path. I don't know
20 that -- I'm not sure exactly what the Examiner is referring to by the main bore,
21 but we believe he is referring to the distribution chamber itself and suggesting
22 that air could rise through the chamber. But even if that were the case, the
23 claim requires that the upwardly-angled path be part of the distributor body,
24 not the distribution chamber. So the distribution chamber of Harding could
25 not meet the upwardly-angled-path element.

1 I believe that lays out our position on the 103 rejection. I'm happy to answer
2 any questions on that or address the 112 rejection if you believe that is
3 necessary based on the 103 over Harding -- I'm sorry, 112.

4 JUDGE COLAIANNI: I don't think it is necessary right now. We understand
5 your position from the Briefs. Any further questions?

6 JUDGE GAUDETTE: No.

7 JUDGE COLAIANNI: Judge Robertson?

8 JUDGE ROBERTSON: No.

9 JUDGE COLAIANNI: Thank you.

10 MR. ALEXANDER: Thank you. Appreciate your time.

11 Whereupon, the proceedings at 1:50 p.m. were concluded.